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EXAMINER

AILES, BENJAMIN A

ART UNIT

PAPER NUMBER

2142

DATE MAILED: 12/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 09/897,237 | Applicant(s) MUNENAKA ET AL. | |
| | Examiner Benjamin A. Ailes | Art Unit 2142 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to correspondence filed 25 September 2006.
2. Claims 1-27 remain pending.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Angles et al. (US 5,933,811), hereinafter referred to as Angles, in view of Prust (US 6,735,623).

6. Regarding claim 1, Angles discloses a content managing system having a content managing portion comprising:

a content library for storing files of a plurality of contents provided by a content provider (Angles, figure 4, item 70);

library managing means for managing said content library (Angles, figure 4, item 18);

Angles discloses in column 14, lines 23-26 the advertisement provider computer having registration capabilities. The registration steps include obtaining information pertaining to users and storing this information about the user in a database. Angles clearly discloses information related to a user but does not explicitly disclose the ability to store files for the user. However, in related art, Prust discloses a method for providing a remote storage area specifically for users in a computer networking environment where it would be considered desirable to store files remotely. The remote storage device disclosed by Prust is divided so that each user is assigned a specific storage area. The user is then able to access the remote storage from different locations over a network communication line from a user terminal. The user is also able to copy and store data files in their storage area (Prust, column 1, lines 30-37). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to provide a "customer file storing means" (remote storage area) as disclosed by Prust, in combination with the registration and user database as disclosed by Angles. One of ordinary skill in the art would have been motivated to make such a combination because of the benefit of being able to access data files from different locations (remote access).

7. Regarding claim 2, Angles discloses the content being advertisements (col. 2, lines 49-51).

8. Regarding claim 3, Angles discloses the content managing system wherein the content provider can freely change, replace, and delete the file of a content provided to said content library (col. 13, lines 21-23 and col. 15, lines 20-42, Angles discloses the advertisement provider having full control over maintaining the content stored (generating and deleting advertisements) in the content database.).

Art Unit: 2142

9. Regarding claim 4, as mentioned in the rejection of claim 1, Angles does not explicitly recite the use of a storage area specifically designated for each user, however Prust teaches this feature at length. Angles does in fact teach a method for statistics gathering. Angles utilizes an accounting database which tracks how often content is used (see Angles, col. 15, line 65 – col. 16, line 7). The reasoning and motivation to combine Angles and Prust as utilized in claim 1 applies equally as well to claim 4.

10. Regarding claim 5, as mentioned in the rejection of claim 1, Angles does not explicitly recite the use of a storage area specifically designated for each user, however Prust teaches this feature at length. Angles does in fact teach a method for statistics gathering. Angles utilizes an accounting database which tracks how often content is used and tracks demographic information including sex (see Angles, col. 14, lines 19-23 and col. 15, line 65 – col. 16, line 7). The reasoning and motivation to combine Angles and Prust as utilized in claim 1 applies equally as well to claim 5.

11. Regarding claim 6, as mentioned in the rejection of claim 1, Angles does not explicitly recite the use of a storage area specifically designated for each user, however Prust teaches this feature at length. Angles does in fact teach a method for statistics gathering. Angles utilizes an accounting database which tracks how often content is used and tracks demographic information including age (see Angles, col. 14, lines 19-23 and col. 15, line 65 – col. 16, line 7). The reasoning and motivation to combine Angles and Prust as utilized in claim 1 applies equally as well to claim 6.

12. Regarding claim 7, as mentioned in the rejection of claim 1, Angles does not explicitly recite the use of a storage area specifically designated for each user, however Prust teaches this

Art Unit: 2142

feature at length. Angles does in fact teach a method for statistics gathering. Angles utilizes an accounting database which tracks how often content is viewed (clicked) (see Angles, col. 4, lines 17-20, col. 14, lines 19-23 and col. 15, line 65 – col. 16, line 7). The reasoning and motivation to combine Angles and Prust as utilized in claim 1 applies equally as well to claim 7.

13. Regarding claim 8, as mentioned in the rejection of claim 1, Angles does not explicitly recite the use of a storage area specifically designated for each user, however Prust teaches this feature at length. Angles does in fact teach a method for statistics gathering. Angles utilizes an accounting database which tracks how often content is viewed. How often content is viewed requires the time and date in order for the statistic to be calculated efficiently (see Angles, col. 14, lines 19-23 and col. 15, line 65 – col. 16, line 7). The reasoning and motivation to combine Angles and Prust as utilized in claim 1 applies equally as well to claim 8.

14. Regarding claim 9, as mentioned in the rejection of claim 1, Angles does not explicitly recite the use of a storage area specifically designated for each user, however Prust teaches this feature at length. Angles does in fact teach a method for statistics gathering. Angles utilizes an accounting database which tracks how often content is used (see Angles, col. 14, lines 19-23 and col. 15, line 65 – col. 16, line 7). The reasoning and motivation to combine Angles and Prust as utilized in claim 1 applies equally as well to claim 9.

15. Claims 10-18 and 19-27 contain similar subject matter and are rejected under the same rationale as claims 1-9.

Response to Arguments

16. Applicant's arguments filed 25 September 2006 have been fully considered but they are not persuasive.

Art Unit: 2142

17. (A) In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant argues with respect to Angles that Angles does not assign a storage area to each user and Angles could not assign a storage area to each user in a customer file storage of applicants' claimed content managing portion. In response, it is noted that Angles is not relied upon for teaching the use of storage to assign an area of the storage to each user or as claimed a "customer file storing means for storing the file of a content of each user to an area assigned to each user." Angles teaches the storage of information related to a user in a database remote from the user in figure 4, items 68 and 72 wherein Angles teaches the use of a registration database and an accounting database but does not explicitly teach the storage of files for individual users or the assignment of a storage area for each user. Prust is relied upon for teaching what Angles does not explicitly teach. Prust teaches a method for providing a remote storage area specifically for users in a computer networking environment where it would be considered desirable to store files remotely. The remote storage device taught by Prust is divided in such a manner as to provide an environment wherein each user is assigned a specific storage area. Access is then enabled to each storage area.

18. (B) In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant argues with respect to Prust that Prust fails to discuss storing content for a user from a content provider and further that

Art Unit: 2142

Prust fails to teach operating a content managing portion by the terminal unit through a network so that a content linked to a page published by the content provider through the network is copied or linked from a library to a user area in the customer file storage area. These arguments are not given any weight because Prust is not relied upon for teaching these aspects of the claimed limitations as evidenced by the rejection set forth above. Prust is only relied upon for teaching remote storage techniques utilized in the computer networking arts. In response to applicant's argument that Prust is nonanalogous art wherein applicants claim that "Prust fails to even relate to a content managing system", it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Prust is deemed relevant in the art for teaching the usage of remote storage and for being with the realm of computer networking.

19. (C) Applicants argue that Angles in view of Prust fail to disclose or suggest applicants' claimed "content managing portion in which content is caused to be stored in a user area responsive to a user operating a remote terminal device". In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "content is caused to be stored in a user area responsive to a user operating a remote terminal device") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). It is unclear from the current claim language what is done by a "remote terminal device"

Art Unit: 2142

to cause content to be stored in a user area. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one of ordinary skill in the art would have been motivated to make such a combination because of the benefit of being able to access data files from different locations (remote access) as set forth above and as taught by Prust in the rejection citations. Also, applicants' arguments with respect to Angles in view of Prust fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

20. Therefore, in view of the above, Angles in view of Prust disclose or at least suggest claims 1, 10 and 19 the claims 2-9, 11-18 and 20-27 which depend directly or indirectly on claims 1, 10 and 19.

Conclusion

21. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Leighton et al. (US 7,103,645 B2) teaches a method and system for providing content delivery to a set of participating content providers.

Jacobs et al. (US 7,103,643 B1) teaches email, software and method and system for distributing advertisements to client devices that have such email software installed thereon.

Ebisawa (US 7,085,733 B2) teaches an apparatus and method for executing a game program having advertisements therein.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin A. Ailes whose telephone number is (571)272-3899.

The examiner can normally be reached on M-F 6:30-4, IFP Work Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571)272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

baa

Beatriz Prieto
BEATRIZ PRIETO
PRIMARY EXAMINER